

REMARKS/ARGUMENTS

Claims 1-20 are pending in the present application. Claims 10 and 20 were amended. Reconsideration of the claims is respectfully requested.

I Interview Summary

Applicants thank Examiner Sangwoo Ahn for the courtesies extended to Applicants' representatives during the April 5, 2006 telephone interview. During the interview, Applicants' representatives discussed the distinction between the claims and the Neumark reference. No agreement was reached as to the allowability of the claims.

II 35 U.S.C. § 102, Anticipation

The Examiner has rejected claims 1, 3-5, 7-12, 14-16 and 18-20 under 35 U.S.C. § 102(e) as being anticipated by *Neumark*, System for Cataloging an Inventory and Method of Use, United States Patent 6,550,674 (April 22, 2003) (hereinafter, "*Neumark*"). This rejection is respectfully traversed.

II.A As to Claim 1, 3-5, and 7-9

The Examiner has rejected claim 1 stating:

As per claim 1, *Neumark* discloses,
A method for updating a retail planogram comprising the steps of reading an electronic transmission from at least one RFID tag in a retail environment located in proximity to a product, using a personal shopper device having a location sensing mechanism (column 4 lines 65 - 66), a memory (column 4 lines 52 - 54), a software means (data file creating capability means there is a software), and an RFID reader (column 4 line 51, column 5 lines 57 - 58), wherein an initial planogram is stored therein (Figure 1, column 5 lines 36 - 64, column 6 lines 6 - 42),
collecting said read electronic location information transmitted from said at least one RFID tag by said shopper device (column 4 lines 52 - 56, column 5 line 57),
analyzing and comparing said collected location information by said software means of said shopper device, with said initial planogram in relation to initial location information of said product with collected location information for said product from said collected information (column 7 line 48 - column 8 line 5),
updating said initial location information for said product in said initial planogram in response to collected location information to provide an updated planogram to display current location information for said product in a current planogram arrangement in said retail environment (column 7 line 48 - column 8 line 5).

Office Action dated February 21, 2006, pp. 2-3.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the

claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

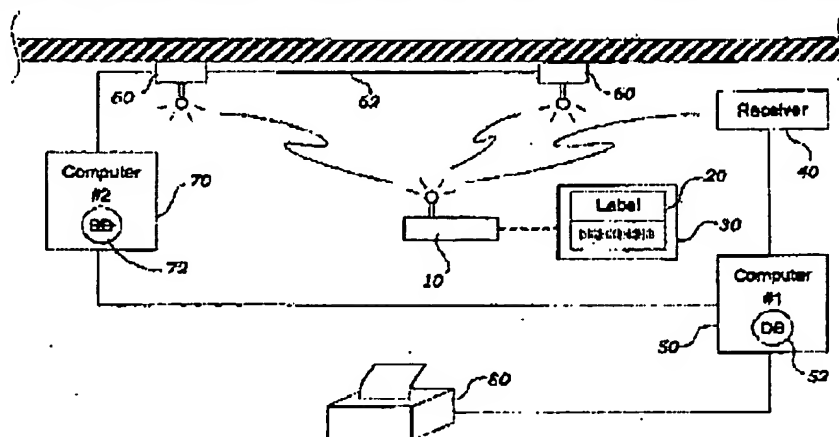
Claim 1 is representative of all claims in this group and recites:

A method for updating a retail planogram comprising the steps of reading an electronic transmission from at least one RFID tag in a retail environment located in proximity to a product, using a personal shopper device having a location sensing mechanism, a memory, a software means, and an RFID reader, wherein an initial planogram is stored therein, collecting said read electronic location information transmitted from said at least one RFID tag by said shopper device, analyzing and comparing said collected location information by said software means of said shopper device, with said initial planogram in relation to initial location information of said product with collected location information for said product from said collected information, updating said initial location information for said product in said initial planogram in response to collected location information to provide an updated planogram to display current location information for said product in a current planogram arrangement in said retail environment.

Neumark does not teach or disclose all of the features in claim 1. For example, the reading step of claim 1 is not taught by this cited reference. *Neumark* also does not teach the analyzing step and the updating step of claim 1.

With respect to the reading step, *Neumark* does not teach, "wherein an initial planogram is stored therein."

The Examiner points to Figure 1 in this cited reference as teaching this feature in the reading step:



Neumark, Figure 1.

At issue are the contents of the reader identified by reference numeral 10 in *Neumark*'s figure 1. *Neumark* describes this reader as "mobile means for reading labels and for communication (R&C). *Neumark* provides the following elaboration of the reader's functions, contents, and capabilities as follows:

The present invention is a method wherein a combination mobile means for reading labels and for communication (R&C) 10 is employed. One such device or hundreds may be used at the same time depending on the size and nature of the inventory management objective. In this description, we refer to a single R&C 10, but it should be realized that many such units would normally be employed simultaneously in the present method. The communication means of the R&C 10 provides two wireless functions. To accomplish its objectives the communication means is able to transmit digital information over relatively short distances, as allowed by FCC rules, employing any well known and common analog or digital wireless communication technique as described in the prior art. It also is able to transmit a low power ultra wide band (UWB) communication signal which is particularly suitable in the present application, as will be shown. Other communication protocols that are well known in communication engineering could be used in place of UWB. Likewise, the label reading means part of the R&C 10 may be any well known optical, mechanical, electrical, electrostatic, or magnetic system for reading bar code or other printed coding. Such inventory labels may be radio tags, bar code labels and other well known tags capable of labeling inventory. However, the reader must be of the type that requires its position to be quite close or in contact with the label to be read. Such proximity readers include magnetic swipe types, optical bar code types, and others. Proximity is necessary because the communication means part of the R&C 10 enables the location of the reader, i.e., the item being read, to be determined. When the reader is close to the item, or touching it, and when the communication means is, likewise, very close, the accuracy of the location is improved. Therefore, it is a preferred technique to use a single, miniature hand-held device with contact label reading and communication capabilities. The importance of the proximity of the R&C 10 to the inventory item will be understood in the following disclosure.

The method includes the step of manually positioning the R&C 10 for taking a reading, and then taking a reading of an inventory label 20 or other indicia affixed to, or adjacent to, a selected inventory item 30 in an inventory stores. This process may be repeated for one item after the next until an entire inventory of stores is taken, or it may be completed for only one or a few items as desired. A common need in inventory management is to determine the nature or identity of inventory items and also their location, and the present method can accomplish this economically and efficiently. The next step in the present invention method is to create a data file in the R&C corresponding to the label reading and a corresponding first time stamp taken at the time of the label reading. Thus, the R&C 10 has a data file creating capability as is known in the art, and also has a time stamping capability, as is also well known in the art.

Neumark, col. 5, l. 36 – col. 6, l. 21.

Neumark describes the reader, the R&C device 10, covering the various aspects of the device's label reading and communications capabilities. The description provides details of types of labels to be read, positioning of the R&C device with respect to the inventory items and labels affixed to those items, and nature of the communication capabilities. Notably absent from the description is the existence of any planogram related computations in the R&C device. In the entire detailed description of the R&C device's capabilities, the data storing capabilities are limited to creating data file and time stamping. No description is provided about storing a planogram in the R&C device.

In addition to *Neumark*'s section cited above, the examiner also cites to the following portion of *Neumark* as teaching this claimed feature:

This step is known, for instance, in the supermarket and grocery trade, each time an item is scanned at a checkout counter, its identity is recorded as a data file, which is then imported into a database and the current known inventory count of the item is reduced by one. Similarly here, the data file is transmitted by wireless communication, as described above and shown in FIG. 1, from the R&C to a receiver 40 using any well known method of moving data from a point of origin to a point where analysis will be conducted, and preferably employs digital wireless transmission. In like manner, the data file is transported, usually over an electrical cable, from the receiver 40 to a first data processor 50 such as any digital computer where the data file is stored in a database as a record. Such a record will contain information such as, item description, item serial or stocking number, item count or quantity, item date, and so on. The record also contains the date and time of day that the reading took place. The data base may contain hundreds, or many hundreds of such records, and the means for creating such a database and of importing information, such as describes here, into the database is very well known in the art.

Neumark, col. 6, ll. 21-42.

As can be seen, this cited section from *Neumark*, explains the R&C device's label reading, data capturing, and communication capabilities. *Neumark* expressly provides for databases in first data processor 50, and second data processor 70, which provide the inventory management function by utilizing data communicated by the label reader R&C device. However, the cited sections from *Neumark* are devoid of any disclosure of a planogram stored in *Neumark*'s label reader. In fact, *Neumark*'s entire disclosure fails to teach or suggest a feature similar to "wherein an initial planogram is stored therein" as recited in claim 1. The claimed feature recites the existence of a planogram in the shopper device. Planogram is defined in the specification, as follows:

a planogram is how a retailer's configure a layout of their respective stores
Specification, p. 2.

Neumark does not disclose storing a planogram in the label reader R&C device. According to *Neumark*'s disclosure, the label reader sends the data to a data processor Computer #1 shown as reference numeral 50 in *Neumark*'s figure 1. *Neumark*'s figure 1 shows, and the detailed description explains that

the data processor is distinct from the label reader, and the data processor provides the database 52 of inventory items. *Neumark's* second data processor Computer #2, shown as reference numeral 70 in *Neumark's* figure 1 provides the computational capabilities for determining the location of the label reader and populates a second database 72 with running account of the label reader's location. The location of an inventory item in *Neumark's* system is then determined by matching item label information from the first database 52, to location information from the second database 72, based on the time of the reading of the label.

Neumark, does not disclose a planogram stored in the label reader device. Therefore, *Neumark* does not disclose any use of an initial planogram resident on the label reader. Not only does *Neumark* not disclose a planogram residing in the label reader, *Neumark* does not even disclose a planogram stored in the two databases. Furthermore, any computations involving locations that may vaguely resemble similar computations involving planograms are carried out in the two data processors, external to the label reader. Therefore, *Neumark*, as a matter of fact, does not teach "wherein an initial planogram is stored therein" as recited in claim 1.

Neumark is not concerned with planograms as defined and used in the invention of claim 1, but only with learning the location of items in the warehouse space at specific times for inventory management. By definition, location of inventory items and a planogram are distinct from each other, and *Neumark* teaches the former, not the latter. The invention of claim 1 as a whole pertains to "a method for updating a retail planogram," and *Neumark* does not teach or suggest updating a retail planogram as in the claimed invention. Therefore, *Neumark* does not teach the feature "wherein an initial planogram is stored therein" as claimed, and cannot suggest storing a planogram in *Neumark's* label reader.

Neumark fails to disclose another feature of the claim 1, namely, "analyzing and comparing said collected location information by said software means of said shopper device, with said initial planogram in relation to initial location information of said product with collected location information for said product from said collected information." Because *Neumark's* invention contains no disclosure of a planogram in the label reader device, *Neumark* cannot teach comparing anything to a planogram in the label reader device. *Neumark* uses the reader only to collect the label information, and uses the label information in conjunction with two separate databases that are external to the reader to identify the location of an item in place and time. The analysis and comparison of the label information does not occur using any software component resident on the reader device, as contrasted with the analysis and comparison activity in the invention of claim 1. Therefore, *Neumark* cannot teach comparing a product location on the initial planogram with the product location as collected by the personal shopper device from reading a product's RFID tag in claim 1.

For the same reason, yet another feature of claim 1 cannot be anticipated by *Neumark*, namely, "updating said initial location information for said product in said initial planogram in response to collected location information to provide an updated planogram to display current location information for said product in a current planogram arrangement in said retail environment." Because *Neumark*'s invention does not contain a planogram, no update of a planogram is possible, and *Neumark* cannot yield a current planogram arrangement as claimed. Therefore, *Neumark* cannot teach updating a product's location in a planogram as claimed in claim 1.

At least for the three features of claim 1 that *Neumark* fails to disclose as described above, *Neumark* does not anticipate claims 1, 3-5, and 7-9 under 35 U.S.C. § 102(e).

II.B As to Claims 10-12, 14-16, 18-20

The Examiner has rejected claims 10-12, 14-16, and 18-20, stating:

As per claim 10, *Neumark* discloses,
A system for updating a planogram comprising,
a portable shopper device having a location sensing means, a software means and
an RFID reader (Figure 1, column 4 line 47 - column 5 line 3)
a retail system comprising a database in communication with said shopper device
(Figure 1, column 4 lines 50 - 60),
an initial planogram stored in said database (column 8 lines 1 - 3), and
one or more product RFID shelf labels positioned in a retail environment
(column 4 lines 50 - 52, column 6 lines 6 - 9),
wherein said RFID reader is capable of reading an electronic transmission from
at least said one or more RFID shelf labels using said personal shopper device
and transmitting collected read electronic information to said database, wherein
said initial planogram is updated in response to collected read electronic
information by said software means and said database is updated with a current
planogram reflecting said collected read electronic information (column 4 line 65
--column 5 line 3, column 7 line 48 --column 8 line 5).

Office Action dated February 21, 2006, pp. 4-5.

Claim 10 in the currently amended form is representative of all claims in this group, and recites:

A system for updating a planogram comprising,
a portable personal shopper device having a location sensing means, a software
means and an RFID reader,
a retail system comprising a database in communication with said shopper
device,
an initial planogram stored in said database, and
one or more product RFID shelf labels positioned in a retail environment,
wherein said RFID reader is capable of reading an electronic transmission from
at least said one or more RFID shelf labels using said personal shopper device
and transmitting collected read electronic information to said database, wherein
said initial planogram is updated in response to collected read electronic
information by said software means and said database is updated with a current
planogram reflecting said collected read electronic information.

Contrary to the Examiner's assertion, *Neumark* does not teach, "an initial planogram stored in said database." In the sections that the Examiner cites from *Neumark* as teaching this claim feature, *Neumark* states:

To determine the location and identity of an item 30 within inventory stores, it now is possible to call-up the record of the item 30, in the first database 52 to determine item identity and time of record, and then by matching the time of location in the second database 72 to the time of record, to obtain location.

Neumark, col. 7, l. 55 - col. 8, l. 4.

The cited sections from *Neumark* are devoid of any disclosure of a planogram stored in *Neumark*'s two databases. In fact, *Neumark*'s entire disclosure fails to teach or suggest a feature similar to "an initial planogram stored in said database" as claimed. The claimed feature recites the existence of a planogram in the database. A planogram is how retailers configure a layout of their respective stores. *Neumark* is not concerned with planograms as defined and used in the claimed invention, but only with learning the location of items in the warehouse space at specific times for inventory management. By definition, location of inventory items and a planogram are distinct from each other, and *Neumark* teaches the former, not the latter. Claim 10 recites specific steps for updating a planogram and *Neumark* does not teach or suggest updating a planogram as claimed. Therefore, *Neumark* does not teach the feature "an initial planogram stored in said database" as claimed in claim 10, and cannot suggest storing a planogram in either of the two databases in *Neumark*'s system.

For the same reasons, *Neumark* also does not anticipate the claimed feature "wherein said initial planogram is updated in response to collected read electronic information by said software means." Where no planogram exists, no planogram can be updated, and no updating of planograms can be taught.

At least for the two features of claim 10 that *Neumark* fails to disclose as described above, *Neumark* does not anticipate claims 10-12, 14-16, and 18-20 under 35 U.S.C. § 102(e).

III 35 U.S.C. § 103, Obviousness

The Examiner has rejected claims 2, 6, and 13 under 35 U.S.C. § 103(a) as being obvious over *Neumark* in view of *Hind et al.*, Method and system for providing targeted advertising and personalized customer services, United States Patent Application 2002/0174025 (Filed, May 17, 2001, Published, November 21, 2003) (hereinafter, "*Hind*"). This rejection is respectfully traversed. The Examiner notes on page 7 of the office action that the obviousness rejection applies to claims 2, 16, and 13, but continues to describe the rejection as against claims 2, 6, and 13. Applicants believe that this is a typographical error in the office action and that the Examiner intended to reject claim 6 and not claim 16 in this group of

rejections. Accordingly, Applicants put forth arguments against obviousness rejection of claims 2, 6, and 13 below.

III.A As to Claims 2, 6, and 13

The Examiner has rejected claim 2 stating:

As per claim 2, Neumark discloses the method of claim 1 as discussed above in 35 U.S.C. 102(a) rejection section.

Neumark does not explicitly disclose said device is fixedly mounted to a shopping cart.

However, Hind discloses said device fixedly mounted to a shopping cart (Figure 3, paragraph 12). It would have been obvious to a person of ordinary skill in the data processing art to combine the above two references because the combination would have provided targeted advertising and personalized service to the customer using the display device on the shopping cart (paragraph 12).

Office action dated February 21, 2006, p. 7.

Claim 2 is representative of all claims in this group and recites:

The method of claim 1, wherein said device is fixedly mounted to a shopping cart.

III.A.i The Proposed Combination Does Not Teach all of the Features of Claim 2

Regarding the features of claim 2, the Examiner has failed to state a *prima facie* obviousness rejection because the proposed combination does not teach all of the features of claim 2. A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). In the case at hand, not all of the features of the claimed invention have been considered and the teachings of the references themselves do not suggest the claimed subject matter to a person of ordinary skill in the art.

Because *Neumark* does not anticipate claim 1 as described in section III.A above, *Neumark* also does not disclose all features of claim 2, which depends from claim 1. *Hind* does not cure these deficiencies in *Neumark* and therefore cannot make obvious the invention of claim 2.

Hind's entire disclosure also fails to teach or suggest use and manipulation of planograms as claimed. *Hind* is concerned with providing targeted advertising and services through a user's mobile device. *Neumark* is concerned with cataloging and managing inventory of items through use of label scanners. The claimed invention is concerned with updating planograms of retail environments through use of RFID readers. *Hind* does not cure *Neumark's* shortcoming in teaching the invention of claim 1, and therefore, considered together with *Neumark* cannot make obvious the invention of claim 2.

Therefore, the Examiner has failed to establish a *prima facie* case of obviousness against claim 2 under 35 U.S.C. § 103.

III.A.II The Examiner Has Not Stated a Proper Teaching, Suggestion or Motivation to Combine the References

In addition, the Examiner has failed to state a *prima facie* obviousness rejection against features of claim 2, because the Examiner has not stated a proper teaching, suggestion, or motivation to combine the references. Instead, the Examiner has only stated a proposed advantage to combining the references. However, an advantage proposed by the Examiner is not a teaching, suggestion, or motivation based on the prior art. To constitute a proper teaching, suggestion, or motivation, the Examiner must establish that one of ordinary skill would both recognize the advantage and have a reason to implement the advantage. For example, a first reference may disclose the use of lasers to achieve nuclear fusion. A second reference may disclose that ultra-high power lasers deliver more energy. One of ordinary skill may recognize that an ultra-high power laser would be more useful to achieve nuclear fusion, though one of ordinary skill would be motivated to avoid combining the references because of the extreme expense of ultra-high power lasers. In this example, one of ordinary skill is motivated to avoid implementing the combination, even if he or she recognized the advantage, and so no teaching, suggestion, or motivation exists to combine the references.

In the case at hand, the Examiner has not provided a sufficient reason why one of ordinary skill would recognize the proposed advantage or have a reason to implement it. Instead, the Examiner points to features in the cited reference that give the Examiner motivation to combine them, rather than pointing to the motivation in the prior art. The Examiner states, "It would have been obvious to a person of ordinary skill in the data processing art to combine the above two references because the combination would have provided targeted advertising and personalized service to the customer using the display device on the shopping cart." However, the proposed motivation does not actually exist because *Neumark's* method discloses no desirability or need for providing targeted advertising to the customer. *Neumark* is concerned with inventory management, not advertising to the customers, whether targeted or not. *Hind* has no component, which participates in an inventory management function that is of interest to *Neumark*. *Neumark* provides a complete system and method for accomplishing inventory management function and is not deficient in supporting that function. Because *Neumark* is not lacking in this capability, *Neumark's* existing disclosure vitiates any putative need for *Hind's* teachings. For these reasons, the Examiner's statement fails to provide a proper teaching, suggestion, or motivation to combine the references. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claim 2.

III.A.iii No Teaching, Suggestion, or Motivation Exists to Combine the References

In addition, a *prima facie* obviousness rejection against features of claim 2, has not been made because no proper teaching or suggestion to combine the references exists in the references. A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). A proper *prima facie* case of obviousness cannot be established by combining the teachings of the prior art absent some teaching, incentive, or suggestion supporting the combination. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990). No such teaching or suggestion is present in the cited references and the Examiner has not pointed out any teaching or suggestion that is based on the prior art.

The references themselves do not suggest the proposed advantage. In the present case, *Neumark* has neither a need, nor an advantage in providing targeted advertising to customers while doing the inventory management. *Neumark's* invention discusses racks tens of feet high, items placed on these racks that are tens of feet high, and discusses the need for the label reader to be in close proximity with the items being read. Clearly, *Neumark* is not intending for customers to be climbing forklifts and ladders to read labels on items situated tens of feet high. *Neumark* is therefore a warehouse, or retail operations oriented application and not a customer-oriented application. When there are no customers, no need arises for providing targeted customer advertisements within the scope of the application. Therefore, no need actually exists in *Neumark*, to combine, or provide motivation to combine *Hind* with *Neumark* to deliver targeted advertising to customers. Accordingly, the Examiner has not actually stated a teaching or suggestion based on the references to combine the references. Instead, the Examiner has only put forth a hypothetical advantage of combining the references based on the Examiner's opinion rather than on a pre-existing teaching, suggestion, or motivation found in the references themselves. Thus, the Examiner has failed to state a *prima facie* obviousness rejection against claim 2.

III.A.iv No Teaching or Suggestion Exists To Combine the References Because Each Reference Represents a Complete Solution to the Problem That Each Solves

Both *Neumark* and *Hind* represent complete solutions to the problems each solves. *Neumark* shows an inventory management system using mobile label readers capable of communication. *Neumark* has no need to address the problem of providing targeted advertising to customers for the reasons explained in section III.A.iii above. *Neumark* represents a complete solution for fashioning such a system. On the other hand, *Hind* shows a system for delivering targeted advertising to customers using customer's own mobile phone and PDA, or a shopping cart mounted device. *Hind* represents a complete solution for fashioning such a system. *Hind* has no disclosure touching upon inventory management aspects of *Neumark*. Because each reference provides a complete solution to the problem that each

reference represents and neither reference indicates that a targeted advertising system can be used for inventory management or vice versa, one of ordinary skill would have no reason to combine or otherwise modify the references. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claim 2.

III.A.v The Examiner Used Impermissible Hindsight When Fashioning the Rejection

In addition, the Examiner has failed to state a *prima facie* obviousness rejection against claim 2, because the Examiner used impermissible hindsight when fashioning the rejection. Personal opinion cannot be substituted for what the prior art teaches because a *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). In this case, the Examiner believes that, "the combination would have provided targeted advertising and personalized service to the customer using the display device on the shopping cart." However, as described above, *Neumark* has no need for targeted advertising to customers because *Neumark* is concerned with inventory management. *Hind* fails to provide a reason to include a shopping cart mounted display device in *Neumark* to somehow contribute towards *Neumark's* system, in the manner claimed by the Examiner. Thus, neither reference teaches or suggests using a display device, as claimed. Given that *Neumark* has no need for displays, and given that *Hind* suggests no reason to use a display in inventory management, one of ordinary skill would have no reason to combine or otherwise modify the references.

Based on the plain disclosures in the references, the only suggestion to modify the references is found in Applicant's specification. Hence, the Examiner must have used Applicant's specification to find a teaching, suggestion, or motivation to combine the references. Doing so is impermissible hindsight and fails to comport with the standards of *Graham v. John Deere Co.*, 383 U.S. 1 (1966), which requires a proper teaching, suggestion, or motivation to combine or modify references to achieve a proper obviousness rejection. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claim 2.

III.A.vi Neumark and Hind Would Not Be Combined By One of Ordinary Skill in the Art Because They Address Different Problems

One of ordinary skill would not combine the references to achieve the invention of claim 2, because the references are directed towards solving different problems. It is necessary to consider the reality of the circumstances—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979). The cited references do not address the same problems.

In the case at hand, *Neumark* shows an inventory management system using mobile label readers capable of communication. *Neumark* has no need to address the problem of providing targeted advertising to customers for the reasons explained in section III.A.iii above. *Hind* shows a system for delivering targeted advertising to customers using customer's own mobile phone and PDA, or a shopping cart mounted device. *Hind* represents a complete solution for fashioning such a system. *Hind* has no disclosure touching upon inventory management aspects of *Neumark*. Furthermore, neither reference is in the area of endeavor of the claimed invention – updating a retail planogram.

Thus, the references address distinct problems that are unrelated to each other. The purpose, method, and systems used, as disclosed in *Hind* are inconsistent with those disclosed in *Neumark* as well as those disclosed in the present invention. Because the references address distinct problems, and each of these problems are further distinct from the problem of the claimed invention, one of ordinary skill would have no reason to combine or otherwise modify the references to achieve the claimed invention. Thus, one of ordinary skill in the art would not combine these references as proposed by the Examiner. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claim 2.

III.B As to Claim 17

The Examiner has also rejected claim 17 under 35 U.S.C. § 103(a) as being obvious over *Neumark* in view of *Hoffman et al.*, Customer Guidance System for Retail Store, United States Patent Application 2002/0178013 (Filed, May 22, 2001, Published, November 28, 2002) (hereinafter, "*Hoffman*"). This rejection is respectfully traversed.

The Examiner has rejected claim 17 stating:

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Neumark* in view of U.S. Publication Number 2002/0178013 issued to Beth Louise Hoffman (hereinafter "*Hoffman*").

As per claim 17, *Neumark* discloses the system of claim 11 as discussed above in 35 U.S.C. 102(a) rejection section.

Neumark does not explicitly disclose a display for displaying an updated planogram.

However, *Hoffman* discloses a display for displaying an updated planogram (paragraph 36). It would have been obvious to a person of ordinary skill in the data processing art to combine the above two references because *Hoffman*'s planogram display device would have enabled *Neumark*'s system to provide visual display to users to enhance personalized services, such as providing location information of a certain product (paragraph 2 -3).

Office Action dated February 21, 2006, pp. 2-3..

Claim 17 recites:

The system of claim 11, further comprising a display for displaying an updated planogram.

III.B.i The Proposed Combination Does Not Teach all of the Features of Claim 17

Regarding the features of claim 17, the Examiner has failed to state a *prima facie* obviousness rejection because the proposed combination does not teach all of the features of claim 17. In the case at hand, not all of the features of the claimed invention have been considered and the teachings of the references themselves do not suggest the claimed subject matter to a person of ordinary skill in the art.

Because *Neumark* does not anticipate claim 10 as described in section II.B above, *Neumark* also does not disclose all features of claim 17, which depends from claim 10. *Hoffman* does not cure these deficiencies in *Neumark* and therefore cannot make obvious the invention of claim 17.

Hoffman is concerned with providing a customer guidance system to assist in locating items on a customer's shopping list via printed or displayed information. *Neumark* is concerned with cataloging and managing inventory of items through use of label scanners. The claimed invention is concerned with updating planograms of retail environments through use of RFID readers. *Hoffman* does not cure *Neumark*'s shortcoming in teaching the invention of claim 10, and therefore, considered together with *Neumark* cannot make obvious the invention of claim 17. Furthermore, because *Hind* also does not cure *Neumark*'s shortcoming in this regard, *Hoffman* and *Hind* together in combination with *Neumark* fail to teach the invention of claim 10, and therefore, fail to teach the invention of claim 17.

Therefore, the Examiner has failed to make a *prima facie* case of obviousness against claim 17 under 35 U.S.C. § 103.

III.B.ii The Examiner Has Not Stated a Proper Teaching, Suggestion or Motivation to Combine the References

In addition, the Examiner has failed to state a *prima facie* obviousness rejection against features of claim 17, because the Examiner has not stated a proper teaching, suggestion, or motivation to combine the references. Instead, the Examiner has only stated a proposed advantage to combining the references. However, an advantage is not necessarily a teaching, suggestion, or motivation. To constitute a proper teaching, suggestion, or motivation, the Examiner must establish that one of ordinary skill would both recognize the advantage and have a reason to implement the advantage.

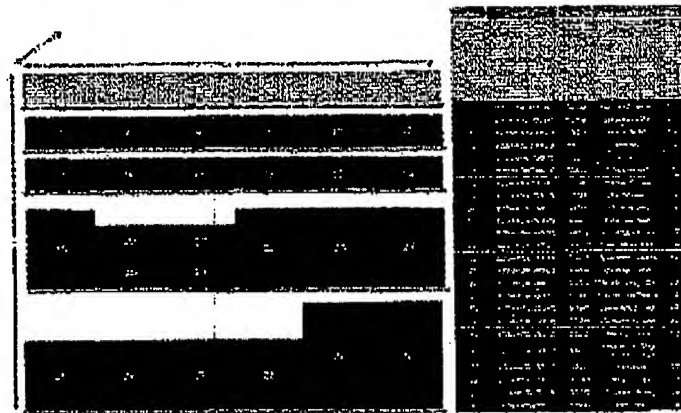
In the case at hand, the Examiner has not provided a sufficient reason why one of ordinary skill would recognize the proposed advantage or have a reason to implement it. The Examiner states, "It would have been obvious to a person of ordinary skill in the data processing art to combine the above two references because *Hoffman*'s planogram display device would have enabled *Neumark*'s system to provide visual display to users to enhance personalized services, such as providing location information of a certain product."

First, the Examiner's characterization of *Hoffman*'s display as a "planogram display" is erroneous because *Hoffman*'s product location information is simply a map and not a planogram. *Hoffman*'s

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disclosure provides no support for the Examiner's mischaracterization of *Hoffman's* location map as a planogram. A map in *Hoffman's* case may be nothing more than a line drawing connecting points, or an ordered listing of product, aisle, and rack information. A planogram displays dimensioned view of the retail space layout and is far more informative than a map that meets *Hoffman's* description and requirements. A sample planogram is shown below to provide a better understanding of the described difference.

Check Out Lane Planogram



Source: http://www.smartdraw.com/examples/fpn-planograms/planogram_schematic.htm

Next, the proposed motivation does not actually exist because *Neumark's* method discloses no desirability or need for providing "visual display to users to enhance personalized services, such as providing location information of a certain product." *Neumark* is concerned with inventory management, not personalized services to the customers, whether enhanced or not. *Hoffman* has no component, which participates in an inventory management function that is of interest to *Neumark*. *Neumark* provides a complete system and method for accomplishing inventory management function and is not deficient in supporting that function. Because *Neumark* is not lacking in this capability, *Neumark's* existing disclosure vitiates any putative need for *Hoffman's* teachings. For these reasons, the Examiner's statement fails to provide a proper teaching, suggestion, or motivation to combine the references. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claim 17.

III.B.iii No Teaching, Suggestion, or Motivation Exists to Combine the References

In addition, the arguments advanced in section III.A.iii above, apply similarly to the rejection of claim 17 as well. A *prima facie* obviousness rejection against features of claim 17 has not been made because no proper teaching or suggestion to combine the references exists in the references. No teaching

or suggestion is present in the cited references and the Examiner has not pointed out any teaching or suggestion that is based on the prior art.

III.B.iv No Teaching or Suggestion Exists To Combine the References Because Each Reference Represents a Complete Solution to the Problem That Each Solves

Both *Neumark* and *Hoffman* represent complete solutions to the problems each solves. The arguments advanced in section III.A.iv above, apply similarly to the rejection of claim 17 as well. Because each reference provides a complete solution to the problem that each reference represents and neither reference indicates that a customer guidance system can be used for inventory management or vice versa, one of ordinary skill would have no reason to combine or otherwise modify the references. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claim 17.

III.B.v The Examiner Used Impermissible Hindsight When Fashioning the Rejection

In addition, the Examiner has failed to state a *prima facie* obviousness rejection against claim 17, because the Examiner used impermissible hindsight when fashioning the rejection. Personal opinion cannot be substituted for what the prior art teaches because a *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d at 783. In this case, the Examiner believes that, "It would have been obvious to a person of ordinary skill in the data processing art to combine the above two references because *Hoffman*'s planogram display device would have enabled *Neumark*'s system to provide visual display to users to enhance personalized services, such as providing location information of a certain product." However, as described above, *Neumark* has no need to provide visual display to users to enhance personalized services because *Neumark* is concerned with inventory management. *Hoffman* fails to provide a reason to include a display device for displaying an updated planogram in *Neumark* to somehow contribute towards *Neumark*'s system, in the manner claimed by the Examiner. Thus, neither reference teaches or suggests using a display device, as claimed. Given that *Neumark* has no need for displays, and given that *Hoffman* suggests no reason to use a display in inventory management, one of ordinary skill would have no reason to combine or otherwise modify the references.

Based on the plain disclosures in the references, the only suggestion to modify the references is found in Applicant's specification. Hence, the Examiner must have used Applicant's specification to find a teaching, suggestion, or motivation to combine the references. Doing so is impermissible hindsight and fails to comport with the standards of *Graham*, 383 U.S. 1, which requires a proper teaching, suggestion, or motivation to combine or modify references to achieve a proper obviousness rejection. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claim 17.

III.B.vi *Neumark and Hoffman* Would Not Be Combined By One of Ordinary Skill in the Art Because They Address Different Problems

One of ordinary skill would not combine the references to achieve the invention of claim 17, because the references are directed towards solving different problems. The arguments advanced in section III.A.vi above, apply similarly to the rejection of claim 17 as well. The purpose, method, and systems of *Hoffman* are inconsistent with those of *Neumark*, and further inconsistent with those of the present invention. Because the references address distinct problems, and each of these problems are further distinct from the problem of the claimed invention, one of ordinary skill would have no reason to combine or otherwise modify the references to achieve the claimed invention. Thus, one of ordinary skill in the art would not combine these references as proposed by the Examiner. Accordingly, the Examiner has failed to state a *prima facie* obviousness rejection against claim 17.

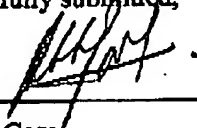
IV Conclusion

Applicants respectfully urge that the subject application is patentable over *Neumark*, in view of *Hind* and *Hoffman*, and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: May 2, 2006

Respectfully submitted,



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